

**REMARKS**

Claims 1-104 are pending in this application. The Office Action withdraws claims 31-39, 43-47, 86-94, 98-102 and 104 as drawn to non-elected subject matter; and rejects claims 1-30, 40-42, 48-85, 95-97 and 103 under 35 U.S.C. §103(a).

**I. Rejection under 35 U.S.C. §103(a)**

Claims 1-30, 40-42, 48-85, 95-97 and 103 are rejected under 35 U.S.C. §103(a) as having been obvious over Hanna et al. (U.S. Patent No. 5,843,417) in view of Bara (U.S. Patent No. 5,919,468). Applicants respectfully traverse the rejection.

Applicants respectfully submit that the combination of Hanna and Bara is improper. Specifically, such a combination is improperly based on hindsight using the presently claimed invention as a roadmap to piece together disparate teachings in the art. A person having ordinary skill in the art would not have combined the teachings of Bara with the teachings of Hanna, for at least the following reasons.

First, Bara is directed to a very different technical problem than either Hanna or the presently claimed invention. Bara teaches a matting agent that seeks to give the skin a matte appearance for an extended time (column 1, lines 58-59) because it does not dry out in the long term (column 2, line 5). Hanna teaches cosmetic products that are waterproof and have transfer resistant properties (column 1, lines 6-7). On the other hand, the presently claimed invention is directed to cosmetic compositions having good slip qualities such that the cosmetic can be distributed uniformly (present specification paragraph [0003]). As is generally known in the art of cosmetics, the problems of matte appearance, water resistance and slip qualities are all independent problems requiring differing solutions. Therefore, a person having ordinary skill in the art of cosmetics would have had no reason to combine a reference directed to one problem with a reference directed to another.

Additionally, Bara also specifically teaches away from including the presently claimed polymethyl methacrylate in cosmetic compositions. The purpose of Bara is to provide an improved matte agent that is superior, according to Bara, to traditional matte agents such as polymethyl methacrylate (column 1, lines 27-33). Bara states that "Matting powders of natural or synthetic origin include fillers such as talc, starch, mica, silica, nylon powders, polyethylene powders, poly-beta-alanine and poly(methyl methacrylates). Fillers of this type have the disadvantage of not imparting a natural appearance to the skin by giving a powdery or even plaster-like appearance and of accentuating skin blemishes" (column 1, lines 27-31). Under MPEP §2145.X.D.1, "A prior art reference that 'teaches away' from the claimed invention is a significant factor to be considered in determining obviousness." Therefore, Bara's very specific teaching away would have discouraged a person of ordinary skill in the art from combining the polymethyl methacrylate taught by Bara with the composition taught by Hanna.

Furthermore, Applicants have demonstrated highly unexpected results. Under both MPEP §716.02 and §2145, the presence of an unexpected property is evidence of non-obviousness. As shown in the attached Declaration under 37 C.F.R. §1.132, the use of polymethyl methacrylate in a cosmetic composition results in highly unexpected advantages with respect to applicability (slip) properties. Specifically, a comparative test was done between a cosmetic composition according to the presently claimed invention and a cosmetic composition including nylon powder but otherwise the same composition. The compositions were prepared substantially in accordance with Example 1 of the present specification (paragraphs [0117] to [0139]). As seen in Table 2 of the Declaration, the composition comprising polymethyl methacrylate showed superior slip qualities. Therefore, the teaching of Bara that additional fillers such as silica, nylon powder, polyethylene power, polymethyl methacrylate powder or its derivatives might be incorporated into cosmetic compositions

would not have rendered the presently claimed invention obvious (even regardless of the above discussed teaching away) because the use of polymethyl methacrylate results in unexpected advantages that distinguish it from the other fillers listed by Bara. In other words, because Bara merely lists the fillers, indicating that they are all equally interchangeable when used in cosmetic compositions, a person having ordinary skill in the art would have had no reason to use polymethyl methacrylate as opposed to any other filler, or to expect the significant improvement achieved by Applicants.

Therefore, due to differing technical problems, teaching away, and unexpected results, the combination of Bara with Hanna is improper. Applicants respectfully submit that the Office Action has improperly conducted a retrospective assessment of the applied references, because a person having ordinary skill in the art would not have combined the teachings of Bara with the teachings of Hanna to practice the presently claimed invention.

Accordingly, independent claims 1 and 49 are patentable over the applied references for at least the reasons discussed above. Dependent claims 2-30, 40-42, 48, 50-85, 95-97 and 103 are therefore patentable for at least the reason that independent claims 1 and 49 are patentable.

Reconsideration and withdrawal of the rejection are respectfully requested.

**II. Conclusion**

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the application are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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WPB:STD/axl

Attachments:

Declaration Under 37 C.F.R. §1.132  
Petition for Extension of Time

Date: January 29, 2008

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